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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,070	09/27/1996	RICHARD G HYATT JR.	P53821C	1185
8439 7590 07/26/2012 ROBERT E. BUSHNELL & LAW FIRM 2029 K STREET NW SUITE 600 WASHINGTON, DC 20006-1004				
EXAMINER				
BARRETT, SUZANNE LALE DINO				
ART UNIT		PAPER NUMBER		
3673				
NOTIFICATION DATE		DELIVERY MODE		
07/26/2012		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

08/720,070

Applicant(s)

HYATT, RICHARD G

Examiner

SUZANNE BARRETT

Art Unit

3673

-- **The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2012.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-56, 64-84, 90-100, 105-116 and 119-127 is/are pending in the application.
- 5a) Of the above claim(s) 43-45, 73 and 94 is/are withdrawn from consideration.
- 6) ☒ Claim(s) 1-42, 46-56, 64-72, 74-84, 90-93, 95-100, 105-116, 119, 121-127 is/are allowed.
- 7) ☒ Claim(s) 120 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-05)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. Claim 120 rejected under 35 U.S.C. 135(b)(1) as not being made prior to one year from the date on which U.S. Patent No. 5,839,307 was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that 35 U.S.C. 135(b) may be used as a basis for *ex parte* rejections.

Claim 120 was not copied from the Field patent 5,839,307 until 4/13/2001, more than one year after the issue date (11/24/1998) of the Field patent.

Note the following timeline in the instant application:

In the amendment of 8/17/1999, applicant added new claim 60 directed to a "lock cylinder" however, this claim was not a verbatim copy of the Field claim, and in fact, differed substantially. The claim recited a lock cylinder instead of a barrel and recited only one locking member rather than the plurality of locking members set forth in the Field claim. Accordingly, it was patentably distinct from the Field claim and cannot be considered a copied claim.

In the amendment of 10/6/1999, applicant cancelled claim 60.

The amendment of 11/30/1999 was not entered.

In the amendment of 3/16/2000, applicant added new claims 85 and 89 directed to a "lock cylinder". Once again, this differed from the Field claim as discussed above.

In the amendment of 4/24/2000, applicant amended claims 85 and 89 to include in claim 85, "blocking" as in the Field claim, but did not cure the absence of the plurality of locking members set forth in Field; and in claim 89, changed to "alignment", but did not cure the omission of the plurality of locking members.

In the amendment of 4/13/2001, applicant filed new claim 120, which is a verbatim copy of the Field claim 14.

Thus, applicant failed to copy the claim within one year of the 11/24/1998 issue date.

Allowable Subject Matter

2. Claims 1-42,46-56,64-72,74-84,90-93,95-100,105-116,119,121-127 are allowed.

Response to Arguments

3. Applicant's arguments filed 4/9/12 have been fully considered but they are not persuasive. Regarding applicant's arguments against the 35 U.S.C. 135(b) rejection of claim 120, it is respectfully submitted that applicant's arguments are not persuasive and the rejection stands.

Specifically regarding the arguments set forth on pages 45-49, and 49-52, category I - Evidence in the Administrative Record, it is respectfully submitted that the claims submitted in the 1998 amendment differed substantially in that they did not recite a "plurality of locking members". While it is agreed that they need not be verbatim copies, it is respectfully submitted that the examiner considers that the claims that recite a "plurality of locking members" are patentably distinct from the claims reciting a single locking member. Accordingly, they are not "the same or substantially the same subject matter".

Specifically regarding the argument on page 52, category II. Absence of Statutory Basis, while it is agreed that the Field filing date is subsequent to the parent application of the instant application, it is nonetheless the fact that Field issued first, therefore this is an interference situation and a notice of allowability cannot be sent in the instant application.

Accordingly, the instant claims stand rejected under 35 U.S.C. 135(b).

Conclusion

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUZANNE BARRETT whose telephone number is (571)272-7053. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Suzanne Dino Barrett
Primary Examiner
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sdb

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